

Appl. No. : 09/574,736
Filed : May 18, 2000

REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Discussion of Claim Rejections Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 1, 4, 5, 7, 16, and 17 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,948,084, to Ha (hereinafter "Ha") in view of Japanese Patent Application No. 09-282065, to Terubumi (hereinafter "Terubumi"), and further in view of U.S. Patent No. 6,396,438, to Seal (hereinafter "Seal"). Claim 2 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha in view of Terubumi, in view Seal, and further in view of U.S. Patent No. 6,311,282 to Nelson. Claims 8, 9, 14, 15, and 19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha in view of Terubumi. Claims 11 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha in view of Terubumi and further in view of U.S. Patent No. 6,392,534 to Flick. Claims 13 and 17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Ha in view of Terubumi in view of Flick and further in view of Seal.

In one embodiment of Applicant's invention, a hand-held controller is provided that includes three assigned buttons that are associated with certain user-defined application programs. Upon selection of the first of the assigned buttons, the computer is powered on and launches a first user-defined application program. Upon selection of a second of the assigned buttons, the computer is powered on and launches a second user-defined application program. Upon selection of the third of the assigned buttons, the computer is powered on without launching a user-defined application program.

Applicant respectfully submits that the prior art fails to teach or suggest providing at least two assigned buttons that when activated causes the power up of a computer and the launching of a selected user defined application. Furthermore, Applicant respectfully submits that the prior art fails to teach, in combination with the foregoing, a third button that when activated causes the power up of a computer without launching any application program. Ha generally describes a remote control for controlling certain application software on a powered up and operational computer. In the Office Action, the Examiner stated that Ha describes an on/off button to

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perform power on sequence of the computer. Applicant respectfully disagrees. Applicant respectfully submits that Ha describes providing an on/off button for controlling application software on the computer system 20, and not the computer system itself. See Ha, col. 3, lines 26-40. Applicant notes that although certain power up functionality is described by Terubumi, neither Terubumi or Ha or the other cited references teach providing the three assigned buttons that includes that have the above-described features.

To establish a *prima facie* case of obviousness certain tests must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the references. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

Applicant respectfully submits that the cited references in isolation and in combination fail to teach or suggest the limitation in Claim 1, as amended, "wherein one of said assigned buttons initiates the power on sequence and the launching of a first user-defined application program and wherein another one of said assigned buttons initiates the power on sequence and the launching of a second user-defined applications." Ha and Terubumi, in isolation or in combination, do not describe assigning at least *two* buttons for (i) *activating power up and launching a user-defined application program*. Similar limitations are recited in independent Claims 8, 11, 14, and 17, as amended. Even if the systems of Ha and Terubumi, were combined, it would not derive the claimed invention. Applicant respectfully submits that neither Ha or Terubumi teach or suggest providing *two dual-function* assigned buttons on a hand-held controller for initiating power-on on a computer and launching user-predefined applications. Furthermore, Ha and Terubumi teach or suggest in addition to the foregoing, providing a *single* function button for initiating power on. Furthermore, Applicant respectfully submits that the Examiner has failed to provide any motivation for the combination of Ha and Terubumi. The fact that the invention that was made, however, does not make itself obvious; the suggestion or teaching must come from the prior art. See, e.g., *Uniroyal, Inc. v. Rudkin-Wilcy Corp.*, 837 F.2d 1044, 1051-52, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) (it is impermissible to reconstruct the claimed invention from selected pieces of prior art absent some suggestion, teaching, or motivation in the prior art to do so); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (it is insufficient to select from the prior art the separate

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components of the inventor's combination, using the blueprint supplied by the inventor); Fromson v. Advance Offset Plate, Inc., 755 F.2d 1549, 1556, 225 USPQ 26, 31 (Fed. Cir. 1985) (the prior art must suggest to one of ordinary skill in the art the desirability of the claims combination). In the case at hand, the Examiner has failed to particularly identify the motivation for combining Ha and Terubumi to provide the three assigned buttons with the associated functionality as is claimed. Therefore, Applicant respectfully submits that the Examiner has failed to make a prima facie rejection in this regard.

Furthermore, Applicant respectfully submits that these limitations are not taught or suggested by Seal or Nelson. Seal was relied upon in the Office Action for the fact that transmission of control signals in the range greater than 100 feet was known in the prior art. Nelson was relied upon in the Office Action for the fact that wireless communication was known in the art.

In the Office Action, the Examiner stated that the attachment of a key ring to a remote control is conventional practice according to Flick. Applicant respectfully submits that in contrast to Flick, the remote control recited in the above-claims is directed to controlling a computer system having varying used-selected application programs. Applicant respectfully submits that the Examiner has failed to identify any particular motivation for including this feature on a remote control for a computer system.

Applicant respectfully submits that since Ha, Terubumi, Seal, Flick and Nelson do not teach or suggest in isolation or in combination at least the above limitations and there is no motivation for their combination, these claims are in condition for allowance. Furthermore, since Claims 2, 6, 7, 9, 12, 13, and 16 each depend on at least one of Claims 1, 5, 8, 11, 14, and 17, Applicant respectfully submits that the claims are allowable for at least the reasons discussed above.

Summary

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory

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requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language. In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly.

Respectfully submitted,

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Dated: 12/8/2003

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